

REMARKS

Claims 10-18 and 21-48 are pending. Independent claims 10, 17, 18 and 41 have been revised to more clearly point out the invention and delete redundant wording. Pages 32 and 36 of the specification have been amended to correct typographical errors. The internal R6 and R7 groups in formula (VII) on page 36 have been revised to be consistent with the body of the claim. Claims 19 and 20 have been cancelled. Accordingly, the Applicants do not believe that any new matter has been added.

The Applicants thank Examiner Covington for the helpful and courteous discussion of September 21, 2004. Structural differences between the prior art compounds and those of Claims 36-48 were discussed and differences between the present method claims (directed to treating disease like dysuria) and the prior art methods (directed to treating obesity and diabetes) were discussed. In view of these differences, it was indicated that the application would likely be in condition for allowance if some other amendments were made to the claims. It was suggested that clarifying amendments be presented including deleting the word "medicament" from Claim 41 and deleting words like "prophylaxis" or "prophylactic" (e.g., claims 10, 17, 18, 43, 46, and 47). It was also indicated that kit claim-type limitations would not distinguish the compounds of claims 19 and 20 from prior art compounds, and the Applicants were encouraged to cancel those claims. The Applicants have now revised the claims in accord with these recommendations. Favorable consideration of this amendment and re-allowance of this application is now respectfully requested.

Rejection--35 U.S.C. §103

Claims 10, 17-20 and 36-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., U.S. Patent No. 5,561,142. Fisher et al. do not render the present invention obvious, because there is no suggestion to treat dysuria (e.g., painful or

difficult urination) as required by independent Claim 10 or the other diseases recited by Claims 17 and 18, e.g., pollakiuria (e.g., frequent urination), cystitis, bladder disfunctions, etc. Instead, Fisher et al. is directed to treatment of diabetes and obesity, see its Title and Abstract. There is no disclosure or suggestion of Fisher et al. to treat bladder or urinary diseases. Accordingly, the Applicants respectfully request the withdrawal of the rejection of method of treatment Claims 10-18, 21-35 and 43.

Claims 36-42 are directed to compounds and compositions or a method for formulating such compositions. Claim 36 is the independent claim. The compound of Claim 36 is not disclosed or suggested by Fisher, because the "A" ring structure on the left side of Fisher formula I (see col. 2, lines 21-25, which corresponds to the bicyclic ring on the right hand side of formula I in Claim 36) is not linked to a nitrogen. The Fisher A ring is linked to -CH(OH)CH₂- instead. Therefore, the compound of Claim 36 is structurally distinct from that of Fisher formula (I).

Claims 44-48 are directed to various methods using the compound of Claim 36 (e.g., agonizing β_3 adrenergic receptors, inducing gut sympathomimetic activity, gastrointestinal disorders, ulcers or pancreatitis or lipolysis), none of which is disclosed or suggested by Fisher. Accordingly, the Applicants respectfully request that this rejection now be withdrawn.

Rejection--35 U.S.C. 112, second paragraph

Claims 10, 17-20, 26, 43 and 36-48 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. These rejections are moot in view of the amendments above.

Rejection--35 U.S.C. 112, first paragraph

Claim 41 was rejected under 35 U.S.C. 112, first paragraph, as lacking adequate description. This rejection is moot in view of the amendment of Claim 41 to remove the redundant language.

Information Disclosure Statement

The Applicants respectfully request that the Examiner fully acknowledge the documents cited on the information disclosure statement submitted February 14, 2002. Reference "AW", Z. Vejdelek et al., Chem. Abstracts 80, No. 7, page 279 (1974) has not been initialed. A copy of Form 1449 previously submitted on February 14, 2002 is attached to this response for the convenience of the Examiner.

CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that this application is now in condition for allowance. Early notification to that effect is earnestly solicited.

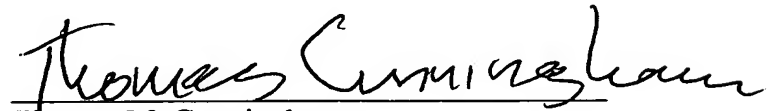
Respectfully submitted,

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Form PTO 1449
(Modified)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY DOCKET NO.

219501US0CONT

SERIAL NO.

New Application

APPLICANT

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FEB 07 2005

LIST OF REFERENCES CITED BY APPLICANT

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						
	AM						
	AN						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AO	EP 0 608 568	8/3/94	EUROPE		
	AP	FR 2 746 395	9/26/97	FRANCE		
	AQ	EP 0 714 883	6/5/96	EUROPE		
	AR	EP 0 611 003	8/17/94	EUROPE		
	AS	WO 96 04233	2/15/96	WIPO		
	AT	WO 96 04234	2/15/96	WIPO		
	AU	WO 98 41497	9/24/98	WIPO		
	AV					

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

	AW	Z. Vejdelek, et al.: "Hypotensive derivative of 5-amino-6,7,8,9-tetrahydro-5H-benzocycloheptene", CHEMICAL ABSTRACTS, Vol. 80, No. 7, pg. 279, column 2, 1974.
	AX	
	AY	
	AZ	

☐ Additional References sheet(s) attached

Examiner

Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.